The opinion in support of the decision being entered today was **not** written for publication and is **not** binding precedent of the Board.

Paper No. 31

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Ex parte ROBERT M. MORIARTY,
RAJU A. PENMASTA,
LIANG GUO,
MUNAGALA S. RAO,
and
RAJENDRA G. MEHTA

Appeal No. 2002-1350
Application No. 09/008,957

ON BRIEF

Before WILLIAM F. SMITH, LIEBERMAN, and GREEN, Administrative Patent Judges.

LIEBERMAN, Administrative Patent Judge.

REMAND TO THE EXAMINER

On consideration of the record, we find that this case is not ready for appeal and thus, we remand the application to the examiner for appropriate action.

The examiner has rejected the pertinent appealed claims as follows:

Claims 1 stands rejected under 35 U.S.C. §103(a) as being unpatentable over Holick '643, Holick '538, Bishop and Gulbrandsen

In the restatement of the examiner's position in the Answer, the examiner concludes that, "(1)the compound is encompassed by the prior art genus; (2) the prior art makes obvious the lower calcemic property of the claimed compound; and (3) applicant's declarations do not show any unexpected result." See Answer, page 6.

The appellants however, have raised another issue not addressed by the examiner. In the section of the Brief, directed to "Secondary Considerations," Brief, pages 11 to 13 and Reply Brief, pages 7 to 10, the appellant presents a substantive argument directed to the fulfillment of "a long felt, but unmet need." See Brief, page 12. Among the evidence submitted in the record of this case are the following;

(1) An editorial published February 5, 1997 in the Journal of the National Cancer Institute, a portion of which is quoted; Id;

(2) An article which is a study by Mehta describing the efficacy of 1 α (OH) D_5 in preventing mammary carcenogenesis published in the Journal of the National Cancer Institute on February 5, 1997 entitled Prevention of Preneoplastic Mammary Lesion Development by a Novel Vitamin D Analogue, 1α-Hydroxy Vitamin D_5.

(3) A second article published November 15, 2000 providing further evidence of vitamin D5's chemo preventative promise entitled Prevention of N-methyl-N-Nitrosourea Induced Mammary Carcenogenesis in Rats by 1α-Hydroxyvitamin D_5;

(4) Funding provided by the United States Army to conduct preclinical toxicity and

Phase 1 trials, submission under 37 CFR § 1.116 December 134, 1999, page 11 and;

(5) A declaration by John E. Nelson directed to unexpected surprising properties of 1α hydroxyvitamin D_5.

It is well settled that among the secondary considerations to be considered by the examiner is "long felt need in the industry." It has been stated that, "[t]hese legal inferences or subtests do focus attention on economic and motivational rather than technical issues and are, therefore, more susceptible to judicial treatment than are the highly technical facts often present in patent litigation." See Graham v. John Deere Co.,383 U.S. 1, 35-36, 148 USPQ 459, 474 (1966). Furthermore these issues, "may also serve to 'guard against slipping into hindsight.'" Id. The selfsame issue of long felt need must be considered by the examiner. It is likewise settled that, "[t]he relevant inquiry before the examiner was whether the claimed invention solved a long-felt need." See Juicy Whip, Inc. v. Orange Bang, Inc., 292 F.3d 728, 744, 63 USPQ2d 1251, 1262 (Fed Cir 2002).

Accordingly, with respect to the issue of long felt need, the examiner must consider the evidence submitted by the appellants and respond thereto by submission of appropriate supporting evidence, arguments and other data as the examiner sees fit. In this respect, the examiner is further directed to issue a Supplemental Examiner's Answer directed to the above issues present in the record before us. A Supplemental Examiner's Answer should include a complete statement of the examiner's views with regard to each of the submissions by the appellants.

APPROPRIATE ACTION

We remand this application to the examiner for action consistent with the above.

As a final point, we emphasize that we have not considered the merits of any of the examiner's rejections. We will do so when the application is in condition for a decision on appeal.

This application, by virtue of its "special" status requires immediate action. See Manual of Patent Examining Procedure (MPEP) 708.01 (8th Ed., Aug. 2001). It is important that the Board be informed promptly of any action affecting the appeal in this application.

REMANDED

WILLIAM F. SMITH
Administrative Patent Judge)
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PAUL LIEBERMAN) BOARD OF PATENT
Administrative Patent Judge) APPEALS
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LORA M. GREEN)
Administrative Patent Judge)

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BULLWINKEL PARTNERS
SUITE 1300
19 SOUTH LASALLE STREET
CHICACO, IL 60603-1493